



UNITED STATES
PATENT AND
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Under Secretary of Commerce for Intellectual Property and
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In re application of
Masahiro Watanabe
Serial No. 09/462,475
Filed: January 14, 2000
For: CATALYST FOR OXIDIZING REFORMED GAS

DECISION ON
PETITION

This is a response to the REQUEST TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION, received April 11, 2002. The request asks that the holding of abandonment, as set forth in the Notice of Abandonment, mailed March 26, 2002, be withdrawn. The requester asserts that the Notice of Non-Compliant Amendment mailed December 26, 2001 was not received at the applicant's correspondence address.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action, TMOG 1156 O.G. 53, November 16, 1993, (see also MPEP 711.03(c) - NEW PROCEDURE TMOG 1170 O.G. 114).

The evidence presented is insufficient to establish that the Office letter, mailed December 26, 2001, was not received by the applicant's or any authorized representative of the applicants. As set forth in MPEP § 711.03(c) II - PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION:

"The showing required to establish the nonreceipt of an Office communication **must** include a statement from the practitioner stating that the Office communication was not received by the practitioner and **attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in the practitioners statement.**" (emphasis added)

The evidence presented is insufficient to establish that the Office letter was not received at the applicant's correspondence address. The evidence provided includes a statement by the requester that "applicant did not receive the Notice of Non-Compliant Amendment mailed December 26, 2001" and a copy applicant's counsel's daily mail log. The request does not contain a statement that a search of the file and docket records was made, and the results of such a search revealed

that the office communication was not received. Further a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed has not been provided and referenced in the practitioner's statement and there is no statement by applicant's representative that the submitted daily mail log is equivalent to the docket records for the instant application.

Regarding the submitted daily mail log, it is noted that the name of applicant's representatives firm and the correspondence address contained thereon do not correspond to the correspondence address of record in the application at the time of mailing of the Notice of Non-Compliant Amendment on December 26, 2001. The correspondence address of record on December 26, 2001 where the Notice of Non-Compliant Amendment was mailed was as follows:

Nikaido Marmelstein Murray & Oram
Metropolitan Square
655 Fifteenth Street NW
Suite 330 G Street Lobby
Washington, DC 20005-5701

Whereas the correspondence address contained on the daily mail log is as follows:

Arent Fox Kintner Plotkin & Kahn, PLLC
1050 Connecticut Avenue, NW
Washington, DC 20036-5339

A review of the instant application file reveals that no change of correspondence address was received in the instant application until a NOTIFICATION OF CHANGE OF NAME AND ADDRESS was submitted by facsimile transmission on March 20, 2002. A further review of the instant application file suggests that applicant's representatives correspondence address change may have been necessary as early as the submission of the papers filed October 10, 2001, these papers contained the same correspondence address thereon as the address that was submitted in the change of address filed March 20, 2002. MPEP § 601.03 states as follows:

601.03 Change of Correspondence Address

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405)..., See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old correspondence address.

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided

correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record. (Emphasis added)

Therefore, it is considered that applicant has failed to show that the holding of abandonment is improper and the application is not in fact abandoned since the Office letter mailed December 26, 2001 was in fact mailed to the correct correspondence address and a change of correspondence address was not promptly filed. It is noted that the approximate 5 month delay between the filing of applicant's correspondence address change and the first appearance of a paper submitted in the application which contains the same correspondence address as was submitted in the change of correspondence address is not deemed as promptly notifying the Office of the change.

The Petition is DENIED.



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